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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,856	09/17/2001	Marcy Makarewicz	IMET0066	8747

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GLENN PATENT GROUP  
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MENLO PARK, CA 94025

EXAMINER
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KREMER, MATTHEW J

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 06/13/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/954,856

Applicant(s)

MAKAREWICZ ET AL.

Examiner

Matthew J Kremer

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-29, 49 and 50 is/are allowed.
- 6) ☒ Claim(s) 1-10, 30-48 and 51-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 31-33 are objected to because of the following informalities: "minimizing" in claim 31, line 1; claim 32, line 1; and claim 33, line 1 should be "limiting" so that the claims are consistent with claim 30. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-48 and 51-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "limiting" in claim 30, lines 3, 5, and 7 is a relative term which renders the claim indefinite. The term "limiting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "limiting" in claim 51, lines 3 and 5 is a relative term which renders the claim indefinite. The term "limiting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "limiting" in claim 52, line 2 is a relative term which renders the claim indefinite. The term "limiting" is not defined by the claim, the specification does

not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "limiting" in claim 54, lines 3 and 5 is a relative term which renders the claim indefinite. The term "limiting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "limiting" in claim 55, line 2 is a relative term which renders the claim indefinite. The term "limiting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recited the limitation "wherein said arm is received by said interface module" which improperly includes a human body part as part of the claimed invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,671,317 to Weishaupt et al. In regard to claim 54, the device of Weishaupt et al. limits variation in placement of a tissue measurement site in relation to the fiber cable. The device of Weishaupt et al. is not attached to the measurement site, which limits surface temperature transients. In regard to claim 55, the fiber optic is attached to the device of Weishaupt et al., which limits variation in pressure.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 30 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,064,897 to Lindberg et al. in view of U.S. Patent 5,671,317 to Weishaupt et al. Lindberg et al. teaches a noninvasive Raman sensor and associated method of measuring at least one parameter of a sample such as a concentration of an

anyalyte. (Abstract of Lindberg et al.). Lindberg et al. teaches that a bifurcated cable contacts a body part. (Figs. 4-5 and 7-8 of Lindberg et al.). Lindberg et al. does not teach a method of attaching the cable to the body part. Weishaupt et al. teaches a method of attaching fiber optics to a skin surface. (Abstract and Fig. 2 of Weishaupt et al.) Such a method would fulfill the requirements of attaching the cable to a body part as disclosed by Lindberg et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify to use the fiber optic holder of Weishaupt et al. in the invention of Lindberg et al. since the method of Lindberg et al. requires a method of attaching the cable to a body part and Weishaupt et al. teaches one such method. In regard to claim 30, the device of Weishaupt et al. limits variation in placement of a tissue measurement site in relation to the optic cable. The fiber optic is attached to the device of Weishaupt et al., which limits variation in pressure. The device of Weishaupt et al. is not attached to the measurement site but on tissue around the measurement site so the combination limits surface temperature transients.

### ***Response to Arguments***

10. Applicant's arguments with respect to claim 30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

11. Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

12. Claims 11-29 and 49-50 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 703-605-0421. The examiner can normally be reached on Mon. through Fri. between 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Winakur can be reached on 703-308-3940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Matthew Kremer  
Assistant Examiner  
Art Unit 3736  
June 8, 2003



ERIC F. WINAKUR  
PRIMARY EXAMINER